DETAILED ACTION

This office action is in response to the amendment filed January 27, 2010. Applicant amended claims 1, 13 and 24. Claims 1, 2, 4, 5, 9-18, 20 and 24-31 are currently pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 4, 5, 9-18, 20 and 24-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites as follows:

> upon receiving a search request containing the search term, determining to place an advertisement for the item on the first page of the search results for the search request when the extent exceeds calculated extents relating the search term to other items for which links to information for said other items appear in the search results for the search request, said determining being independent of a page number of the search results on which the link for the item is configured to be displayed, wherein said search results are to be provided to a consumer computer system different from said one or more computer systems, and wherein the link for the item is distinct from the advertisement for the item.

Applicant's specification teaches as follows:

[0003] Some search engine services do not charge a fee to the providers of web pages for including links to their web pages in search results. Rather, the search engine services obtain revenue by placing advertisements along with search results. These paid-for advertisements are commonly referred to as "sponsored links," "sponsored matches," or "paid-for search results." A vendor who wants to place an advertisement along with certain search results provides a search

engine service with an advertisement and search terms. When a search request is received, the search engine service identifies the advertisements whose search terms most closely match those of the search request. **The search engine service then displays those advertisements along with the search results. If more advertisements are identified than will fit on the first page of the search results, the search engine service selects to display on the first page those advertisements belonging to the vendors that have offered to pay the highest price (e.g., placed the highest bid) for their advertisement. The search engine services can either charge for placement of each advertisement along with search results (i.e., cost per impression) or charge only when a user actually selects a link associated with an advertisement (i.e., cost per click).**

Summary of Invention Paragraph - BSTX (6):
[0004] Advertisers would like to maximize the effectiveness of advertising dollars used to pay for advertisements placed along with search results. Thus, advertisers try to identify search term and advertisement combinations that result in the highest benefits (e.g., most profit) to the advertiser. It would be desirable to have techniques that would allow advertisers to maximize the effectiveness of their advertising dollars by identifying effective advertisement and search term combinations. Moreover, it would be desirable to have an automated way to identify such effective combinations, determine an amount to pay for placement of the advertisements, and provide the combinations to search engine services for placement of the advertisements along with search results that match the search terms.

[0018] In one embodiment, an advertisement generator determines where to place an advertisement for an item based on previous selections of links associated with that item that were included in search results. For example, if a link is presented on the third page of a search result and a user selects that link, then it may be assumed that the user thought that link was especially relevant to the search request because the user had to view several pages of the search result to find that link. In general, the advertisement generator identifies those links that were not prominently displayed in a search result but were nevertheless selected by users. *The advertisement generator then generates an advertisement set that includes an advertisement for the item associated with the links, the search terms associated with the search request,* ***and a link to a web page with information about the item****. That advertisement is then submitted to a search engine service* ***so the advertisement can be displayed prominently along with the search results of search requests that use those search terms****. In this way, the advertisement generator identifies search term and item combinations that may be used to produce very effective advertisement sets.*

The specification teaches that the advertisement is displayed along with the search result however does not disclose the determining being independent of a page number of the search results on which the link for the item is configured to be displayed, wherein said search results

are to be provided to a consumer computer system different from said one or more computer systems, and wherein the link for the item is distinct from the advertisement for the item.

Claims 13 and 24 are also rejected for the same reason. All dependent claims are also reject since they depend on rejected claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble recites determining when to *place an advertisement* ***for an item on a first page*** *of search results for a search request related to the item*, the method comprising: search data including:

search terms submitted by users;

Placement of ***links*** *to information for* ***the item*** within … whether the user selected ***the link*** *for the item* … determining **an extent relating a search term to an item** to extent being a function of at least:

a frequency of selection **of a link to information for the item** when the link is displayed; **and a page number on which the link** was presented in a set of search results generated by execution of the search term, the extent being determined to be greater for a higher page number at the same frequency of selection;

If more than one link is placed for an item it is unclear which link is considered "the link". The claim also recites a frequency of selection of a link but the claim recites receiving whether the users selected the link, but does not positively recite a link is selected. Therefore, it is unclear how frequency of selection can be determined if the search data does not include selection of any link or of a particular link. The claim also does not show relationship between the link to an item (selected link) and the frequency of selection of a link. In other words the claim recites a frequency of selection of a link, not frequency of selection of the selected link (selected link from previously placed search result).

The claim also recites upon receiving a search request containing the search term, determining to *place an advertisement for the item* on the first page of the search results for the search request when the extent exceeds calculated extents relating the search term to other items for which links to information for said other items appear in the search results for the search request, said determining being independent of a page number of the search results on which the link for the item is configured to be displayed, wherein said search results are to be provided to a consumer computer system different from said one or more computer systems, and wherein the link for the item is distinct from the advertisement for the item.

It is unclear which link is distinct from the advertisement since the claim recites different search terms, different links and different items.

Claim 2 recites wherein *the first page* of the search results for the search request *excludes any link to* ***information for the item*** *that is unassociated with the advertisement*. Since claim 1 recites the link for the item is distinct from the advertisement, it is unclear what kind of links the

first page includes, if (according to claim 1) the determining (placing of an advertisement, different than the link, on the first page) is independent of a page number of the search results on which the link for the item is configured to be displayed.

Even if the claim was positively reciting that the search data includes, information regarding selection of a link, frequency of selection of the said link, and the page number where the said link was selected, once the extent (score) of the selected item is determined it is still unclear if the link for the previously selected item is specifically is not place on the first page along with the advertisement in order for the advertisement to be considered distinct from the currently displayed link or the previously selected link.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4, 5, 9-18, 20 and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thrall (US 2005/0120311 A1) in view of Cheung et al. US 7,076,479 B1).

Regarding claims 1 and 4, 5, 9-14, 20, 24, 25 and 31, Thrall teaches under control of one or more computer systems configured with executable instructions; receiving search data relating to previously-executed searches the search data indicating search terms submitted by users; placement of links to information for the item, whether users selected the link for the item from the search results; determining extent (score) based on frequency of selection; the score being greater for the a higher page (see abstract, [0007]- [0020], [0075]-[0080]). Thrall teaches using

the score to determine the rankings for the display of future search result for example by displaying the link for the item toward the top of the future search result *(first page)* (see [00009]-[0011], [0074]). *Thrall teaches that relevant images buried in search results tend to migrate upwards in future search results. In this case the relevant images (advertisement) which migrates upwards (first page) is distinct from the links that were buried in the previous search result.* But if applicant intended to claim that paid advertisement is different (distinct) from the search result (unpaid) and the paid advertisement is placed on the first page or above the unpaid listings, Cheung teaches advertiser biding for placement of advertisement and the advertiser's listing displayed separate from the list of search results or even in a separate web browser windows (see col. 7 lines 3-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for an advertiser to use Thrall's score of a selected link and to bid high for placement of an advertisement (distinct from the link) prominently on the first page or above the unpaid listings.

Regarding claims 15-18, 26-30, Cheung teaches wherein fee is paid for requesting placement of the advertisement; advertisement paid for on a cost-per-selection (col. 6 line 43 col. 7 line 53). It would have been obvious to one of ordinary skill in the art at the time of the invention for advertisers to pay for each click-through as in Cheung, which is cost-effective (see col. 1 lines 20-55).

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 4, 5, 9-18, 20 and 24-31 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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